

Nearly all the newly added claims are simply old dependent claims written in independent format. The correspondence of the new claims to the old claims is noted in parentheses after the claim numbers for the Examiner's convenience.

An anticipation rejection requires that the Examiner show where each and every claim element is located in the prior art reference. The Examiner has not made that showing. Applicants respectfully contend. Specifically, MPEP Section 2131 provides:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 1053 (Fed.Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed.Cir. 1989). The elements must be arranged as required by the claim...

Regarding the Section 103 rejections, MPEP Section 2143 provides in part, "[t]o establish a prima facie case of obviousness ... the prior art reference ... must teach or suggest all the claim limitations." (emphasis added). The recent decision of the U.S. Court of Appeals for the Federal Circuit in *In Re Lee*, 61 USPQ2d 1430, is particularly pertinent to this issue. At page 1433 the court addresses the purpose of the Administrative Procedure Act which requires administrative agencies, including the Patent Office, to not only have reached a sound decision, but to have articulated the reasons for that decision. This applies to patent prosecution in the Patent Office and before the board and subsequent review. In addressing the issue of obviousness the court noted that rejections under 35 USC 103 must be based on evidence comprehended by language of that section. The court cites a series of cases requiring the showing of a suggestion, teaching or motivation to combine prior art references as an essential component to an obviousness holding. The Patent Office Board of Appeals in the *Lee* case had rejected the need for any specific hint or suggestion in a particular reference to support the combination of prior art teachings. The Board had relied upon basic knowledge or common sense. In essence, the Federal Circuit required that there must be evidence of the showing of a suggestion, teaching or motivation to combine the state of the art.

The cited references alone or in combination fail to teach or suggest all of the claim limitations. For many of the claim elements the Examiner has simply stated that the reference

relates to a label construction which comprises the elements without pointing out specifically where the reference shows (such as by reference number) each of the elements. The Examiner has thereby clearly not made out a *prima facie* case. See *In re Epstein*, 31 USPQ2d 1817, 1825 (Fed.Cir. 1994) and *In re Oetiker*, 24 USPQ2d 1443, 1447 (Fed.Cir. 1992). His Section 103 rejections must thus be withdrawn.

As examples only, the Examiner has not shown where the following elements are found in the prior art (such as by patent, column and line numbers). Accordingly, these claims are not properly subjected to 102 or 103 rejections based on the applied art.

Claim 174, the liner sheet portions and the liner sheet bar as defined therein.

Claim 175, the ties which connect the labels together went on the liner sheet and allow the labels to be separated to position them in the separated position.

Claim 176, the first liner strip, the first liner body portion, the lined second labels and the removable second liner strip disposed substantially between the aligned facestock and the first and second lines of labels.

Claim 178, the thin facestock necks which are breakable by a user to separate the facestock labels.

Claim 179, the protruding portions to which respective facestock labels are adhered before the liner strip is in the separated position.

Claim 180, the top edges of the facestock labels being freestanding and unattached to the facestock when the liner strip is in the separated position.

Claim 181, the stack of tab divider sheets having staggered tabs.

Claim 184, the longitudinally aligned facestock labels and the liner strip being repositionable to a separated position as defined.

Claim 186, the liner strip, the labels and the adhesive as defined therein.

Claim 187, the serially-connected strip portions inner connected by thin necks.

Claim 190, the aligned first facestock labels, the aligned second facestock labels disposed parallel to, and spaced from, the first facestock labels.

Claim 191, the first and second facestock portions separated by a thin space as defined therein.

Claim 192, the breakable ties as defined therein.

Claim 193, the facestock labels in their exposed positions as defined therein.

Claim 194, the die cut line and the adhesive as defined therein.

Claim 195, the liner sheet backing strip as defined therein.

Claim 196, the breakable facestock thin connector strips as defined therein.

Claim 197, the facestock handle portion and the liner sheet cut lines as defined therein.

Claim 200, the handle portion and the liner sheet portion as defined therein.

Claim 205, the liner sheet weakened lines and the facestock sheet weakened lines as defined therein.

New claims 218 and 219 are simply old, allowable dependent claims 56 and 134, respectively, rewritten in independent format.

Claim 220, the first facestock strip adhered to the first liner strip and the second facestock strip adhered to the second liner strip.

Claim 221, first and second liner sheet portions, first and second liner strips, and a weakened separation line.

Claims 222, 224 and 225, at least three longitudinally aligned facestock labels, each having the same size and shape.

The different positions, configurations and so forth in the claims are positive (structural) limitations, Applicants respectfully contend, and thus must be considered in a patentability determination. They are not simply unpatentable intended future uses, as the Examiner contended.

Referring to the top of page 3 of the Examiner's Action, it is not seen where Gelsinger teaches the "liner strip" as specifically defined in the claims.

Paragraph 3 on page 3 in the Examiner's Action is not understood.

It is thus respectfully submitted that the subject application is in condition for allowance. If there are any remaining issues, the Examiner is encouraged to telephone counsel at (310) 788-5053 to seek to resolve them.

Please charge any additional fees required by this paper or credit any overpayment to
Deposit Account No. 16-2230.

Respectfully submitted,



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